

Serial No. 11/595,113
Filed: 02/21/2006
Page 6 of 8

Examiner: David B. Thomas
Group Art Unit: 3723

REMARKS

Claims 1-20 and 40 are pending in the application. By this amendment, claims 3, 6-8, 12, 14, and 20 have been amended, claims 1 and 2 have been canceled, and new claim 41 has been added. New claim 41 corresponds to claim 2 rewritten into independent form, and the amendments to claims 3, 6-8, 12, 14, and 20 correct dependencies as a result of rewriting claim 2 into independent form as claim 41.

Applicant believes the amendments made herein add no new matter. Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based on prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to be attached thereto. Reconsideration and reexamination of the application is respectfully requested in view of the amendments and the following remarks.

Claims 1-20 and 40 stand rejected under 35 U.S.C. § 102(f) allegedly not invented by Applicant. The rejection is respectfully traversed.

Claims 1 and 2 have been canceled and effectively replaced with new claim 41, which corresponds to claim 2 rewritten into independent form. The rejection of claims 1 and 2, therefore, will be discussed with respect to claim 41.

The Examiner has identified U.S. Patent Application No. 10/711,117 to VanderBaan as disclosing the claimed subject matter; however, a 102(f) rejection of the claims based on the VanderBaan application is not appropriate, as explained below.

First, both applications claim the benefit of provisional patent applications, and the filing date of the earliest provisional patent application for the present application is before that of the provisional patent application for the VanderBaan application. In particular, the VanderBaan application claims the benefit of U.S. Provisional Patent Application No. 60/498,094, filed August 26, 2003. The present application claims the benefit of two provisional patent applications, U.S. Provisional Patent Application No. 60/481,277, filed August 22, 2003, and U.S. Provisional Patent Application No. 60/521,253, filed March 19, 2004. The subject matter of at least the independent claims in the present application, claims 40 and 41, is supported by

the disclosure of the '277 provisional application; therefore, the claims are entitled to the '277 provisional application filing date of August 22, 2003, which is four days prior to the filing date of the VanderBaan '094 provisional application. It follows that the effective date of invention for the present application is prior to that of the VanderBaan application, and the § 102(f) rejection of the claims in the current application in view of the VanderBaan application is not proper.

Second, the claims of the present application are not disclosed in the VanderBaan application. Claim 41 requires an actuator including a connector between the handle and the diverter so that the diverter moves between the dry suction position and the wet suction position as the handle rotates between a dry suction position and a wet suction position, and claim 40 requires a diverter coupled to the handle such that movement of the handle moves the diverter between the dry suction position and the wet suction position. Thus, the independent claims have the limitation that rotation (claim 41) or movement (claim 40) of the handle moves the diverter, which is not taught by the VanderBaan application. In all embodiments described in the VanderBaan application, the diverter moves by actuation of a switch on the handle and is not responsive to rotation of or any other movement of the handle, as required by the claims of the present application. Because the VanderBaan application does not disclose the subject matter of claims 41 and 40, it also does not disclose the subject matter of the dependent claims, claims 3-20. Without disclosing the claimed subject matter, there is no invention of claims 3-20, 40, and 41 by VanderBaan.

In summary, because the filing date of the earliest provisional patent application for the present application, August 22, 2003, is before that of the provisional patent application for the VanderBaan application, August 26, 2003 and because the VanderBaan application does not fully disclose the claimed subject matter, the § 102(f) rejection is inappropriate. Applicant respectfully requests withdrawal of the rejection.

Claims 1 and 12-16 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting. The rejection is respectfully traversed.

Serial No. 11/595,113
Filed: 02/21/2006
Page 8 of 8

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The Examiner avers that claims 1 and 12-16 are not patentably distinct from claims 38-45 of the VanderBaan application. While the Applicant does not agree and believes that the claims are patentably distinct, the Applicant has nonetheless canceled claim 1 and replaced it with claim 2, which is not included in the rejection, rewritten into independent form as claim 41 to advance the prosecution of this application. As described above, the subject matter of claim 41 has not been disclosed in the VanderBaan application and, further, is not included in any of the claims of the VanderBaan application. None of the claims of the VanderBaan application, much less claims 38-45, include the concept of the diverter moving between the dry suction position and the wet suction position as the handle rotates between a dry suction position and a wet suction position, nor would this concept be obvious in view of the claims of the VanderBaan application. It follows that no obviousness-type double patenting exists, and the Applicant respectfully request withdrawal of the rejection.

If there are any outstanding issues which the Examiner feels may be resolved by way of telephone conference, the Examiner is cordially invited to contact the undersigned to resolve these issues. Early notification of allowability is respectfully requested.

Respectfully submitted,

JOHN L. JANSEN

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By: /John E McGarry/

John E. McGarry, Reg. No. 22,360
McGARRY BAIR PC
32 Market Ave. SW, Suite 500
Grand Rapids, Michigan 49503
(616) 742-3500

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